REMARKS/ARGUMENTS

This is in response to the Office Action mailed 06/14/2005. By this response, claims 14 and 17 have been amended. No new claims have been added. Claims 12-19 remain in consideration.

Allowable Subject Matter

It was stated that claims 14-17 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base and any intervening claims. Applicant appreciates acknowledgement of the patentable subject matter. Claims 14 and 17 have been amended, as above, to incorporate all of the limitations of the base and any intervening claims. Claims 15 and 16 are dependent upon now allowable claim 14. Reconsideration of claims 14-17 is respectfully requested.

Claim Rejections – 35 U.S.C. §103(a)

Claims 12, 13, 18, 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lawrie* (USPN 5,979,257) in view of *Tabata*, et al. (USPN 5,833,570). It was stated that *Lawrie* discloses a method for scheduling shifts from a fixed ratio mode to a first and second mode in an electrically variable transmission including, *inter alia,* input and output members, first and second clutches, first mode characterized by simultaneous first clutch application and second clutch release, second mode characterized by simultaneous first clutch release and second clutch application. It was also stated that *Lawrie* does not disclose time-rate of change of the first signal, but that *Tabata* disclosed a second signal as the time-rate of change of the first signal. It was stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Lawrie* by combining calculating a second signal as the time rate change of the first signal to control the shifting action.

Applicant respectfully traverses the rejection of claims 12, 13, 18, 19 under 35 U.S.C. §103(a) as being unpatentable over *Lawrie* in view of *Tabata*. As the examiner is well aware, for a rejection based upon 35 U.S.C. §103(a) to prevail, the examiner must meet the

burden of establishing a *prima facie* case of obviousness, i.e. that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combine references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ2d 494, 496 (CCPA 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 USPQ2d 1016, 1023 (Fed. Cir. 1996).

Applicant respectfully argues that the *prima facie* case of obviousness has not been met because neither *Lawrie* nor *Tabata* teach nor disclose the method for scheduling shifts from a fixed ratio mode to a first and second mode in an electrically variable transmission as described in claim 18 of the instant invention. Claim 18 of the instant invention sets forth a method for scheduling shifts from a fixed-ratio mode to first and second modes in an electrically variable transmission including an input member and an output member, first and second clutches, said first mode characterized by simultaneous first clutch application and second clutch release, said second mode characterized by simultaneous first clutch release and second clutch application, said fixed-ratio mode characterized by simultaneous first and second clutch applications wherein the transmission input member is mechanically coupled to the transmission output member through a predetermined fixed ratio.

In contradistinction to the invention of claim 18, *Lawrie* teaches a hybrid powertrain system which includes a single clutch mechanism 16, and a control system therefor. (*See e.g.*, Fig. 2, and Col. 6, lines 29-33, Col. 6, lines 49-50; Col. 8, lines 62-66.) Because *Lawrie* fails to teach or disclose first and second clutches, *Lawrie* further fails to teach either a first mode characterized by simultaneous first clutch application and second clutch release, or a second mode characterized by simultaneous first clutch release and second clutch application. Therefore, the instant invention of claim 18 is patentably distinguishable over *Lawrie* in view of *Tabata*, because all elements of the invention are not disclosed in the prior art, as is

required under 35 U.S.C. §103(a). Therefore, claim 18 is allowable over the cited art.

Claims 19, 12, and 13 ultimately depend upon allowable claim 18, and are therefore also patentably distinguishable. Reconsideration of claims 18, 19, 12, and 13 is respectfully requested.

Conclusion

The applicant believes that the invention, with claims 12-19, is now in condition for allowance, and a notice of allowance is earnestly requested. If the Examiner has any questions regarding the contents of the present response he may contact Applicants' attorney at the phone number appearing below.

Respectfully submitted,

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